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Deanna J Shirley 3418 Baldwin Way Santa Rosa, CA 95403				
EXAMINER				
MEDWAY, SCOTT J				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/562,341

**Applicant(s)**

SCHNEIDER, M. BRET

**Examiner**

SCOTT MEDWAY

**Art Unit**

3763

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/23/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. PCT/US2004/020159 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group II and Species D in the reply filed on 11/20/2008 is acknowledged.

Claims 1-7 and 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups II and III, there being no allowable generic or linking claim. The requirement is deemed proper and is therefore made **FINAL**.

In the reply filed 11/20/2008, claims 21 and 22 were newly added. Claim 8 was amended. Thus, claims 8-13, 21 and 22 are currently pending.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has invoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the Specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the Specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o). Also see MPEP 2181 (Rev. 1, Feb. 2000).

Appropriate correction is required.

#### ***Claim Objections***

4. Claim 8 is objected to because of the following informalities: It is the Examiner's position that Applicant has invoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner has objected to the claims for reasons set forth above in the objection to the specification.
5. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 8-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Brock (U.S. Pat. 7,297,142 B2).**

Regarding claim 8, Brock discloses an apparatus for manipulating elongate members during a medical procedure, comprising a base (42) coupled to an elongate member, the base comprising a stand (43) and a module (40), the module comprising a housing (44) rotatable about the elongate axis and comprising an interior for engaging the member therethrough, the housing comprising means for advancing the retracting the elongate member over a distance not limited by the housing (see Fig. 7 of Brock). The apparatus further contains a first motor (13) in the form of a driver (e.g. 50) coupled to the base to advance or retract the elongate members and a second motor (565) to rotate the base.

Regarding claim 9, the relative speed of the two motors provides coordinated motion (col. 7, lines 15-20).

Regarding claim 10, Fig. 7 of Brock shows wheels (29, 608, 626) which advance or retracts the elongate members.

Regarding claim 13, a computer system (9) receives user input to direct the first and second motors.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brock (U.S. Pat. 7,297,142 B2) in view of Lee et al (U.S. Pat. 7,331,967, hereinafter "Lee").**

Regarding claim 11, it is noted that Brock does not show a biasing mechanism. Lee discloses a surgical instrument coupling mechanism having elongate members which are controlled by user input and operated by a variety of motors, further comprising a wheel (308) for advancing or retracting the elongated members, with a

guide post interpreted as a biasing mechanism (e.g. 718) to bias the elongate member against the wheel. It would have been obvious for one of ordinary skill in the art at the time of the invention to considering implementing a biasing mechanism suggested by Lee into the device of Brock, so as to more easily control elongated members by ensuring that the wheel for retracting or advancing the members comes in contact with the elongated members most easily and accurately, and a biasing mechanism of Lee would be suitable to accomplish this task.

**11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brock (U.S. Pat. 7,297,142 B2) in view of Ferry et al (U.S. Pub. 2002/0177789 A1, hereinafter "Ferry").**

Regarding claim 12, it is noted that Brock does not disclose a clip. Ferry discloses a system and methods for advancing a catheter, comprising an elongated member (330) which is fastened to a motorized advancing and retracting means with a clip (332). It would have been obvious for one of ordinary skill in the art at the time of the invention to fasten a clip such as that taught by Ferry to the invention of Brock so as to more securely fasten the elongate member or to allow the elongate member to be clipped and unclipped so as to be inserted into the device at an point in its length, with the expected result of providing manual advancement.

**12. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brock (U.S. Pat. 7,297,142 B2) in view of Robertson et al (U.S. Pat. 5,397,859).**

It is noted Brock discloses the claimed invention except for where the housing comprises a clamshell configuration having a first open and second closed position. Robertson discloses an enclosure for cables, which has a housing (10) with a clamshell configuration and two operating positions (see Fig. 6). It would have been obvious for one of ordinary skill in the art at the time of the invention to consider using a clamshell configuration housing with two positions taught by Robertson in the device of Brock, since doing so would provide an easy way to remove an elongated member from its housing for the purposes of replacement or cleaning and as suggested by Robertson, is useful to protect or access sensitive working parts such as parts disclosed by Brock, located within the housing.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is directed to the *Notice of References Cited*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT MEDWAY whose telephone number is (571) 270-3656. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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01/27/2009

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